

## REMARKS

### **Formal Matters**

Claims 1-56 are pending.

Claims 1-43 were examined and rejected, claims 44-56 being withdrawn from further consideration.

Applicants respectfully request reconsideration of the application in view of the remarks made herein.

### **Objection to Claim 28**

An objection was made to claim 28 in view of the typographical error appearing therein. In view of the above amendment to Claim 28, this objection may be withdrawn.

### **Rejection of Claim 38 under 35 U.S.C. § 112, 2nd ¶**

Claim 38 has been rejected pursuant to 35 U.S.C. § 112, 2nd for an asserted lack of clarity with respect to the use of the term "binding affinity" in the claim. However, the specification at page 5, line 19 to page 6, line 3, provides a clear definition of this term and how it is used in the present application, such that the claim language is definite to one of skill in the art in view of the specification. Accordingly, this rejection may be withdrawn.

### **Rejection of claims under 35 U.S.C. § 103 – Gamble in view of Dorsel**

Claims 1 and 2 are rejected under 35 U.S.C. § 103 (a) as being unpatentable over Gamble (5,981,733) in view of Dorsel (2002/0132261).

The Applicants submit that the subject matter of the cited Dorsel patent and the claimed invention were, at the time the invention was made, assigned or under obligation of assignment to Agilent.

35 U.S.C. 103 (c) states that subject matter developed by another person shall not preclude patentability under 103(a) where the subject matter and the claimed invention were, at the time the invention was made, owned by the same

person or subject to an obligation of assignment to the same person.<sup>1</sup>

According to 35 USC § 103(c), therefore, the Dorsel patent cannot preclude the patentability of the rejected claims if the Dorsel patent and the instant application were assigned to the same person or subject to an obligation of assignment to the same person, at the time the instant invention was made.

The invention claimed in the instant patent application was owned by Agilent Technologies, Inc. ("Agilent") or subject to an obligation of assignment to Agilent at the time the instant invention was made, as evidenced by an assignment executed by the inventors (Reel/Frame 013522/0053). This assignment was recorded on March 27, 2003.

The Dorsel patent was owned by Agilent or subject to an obligation of assignment to Agilent at the time the instant invention was made, as evidenced by an assignment executed by the inventors (Reel/Frame 010749/0364). This assignment was recorded on April 10, 2000.

Thus, the Dorsel patent and the claimed invention were, at the time the invention was made, assigned or under obligation of assignment to Agilent. Accordingly, Dorsel cannot preclude patentability of the instant claims under 103(a).

In view of the disqualification of Dorsel as a prior art reference, this rejection of claims 1 and 2 under 35 U.S.C. § 103(a) may be withdrawn.

**Rejection of Claims 3-37 under 35 U.S.C. § 103 – Gamble in view of Dorsel and further in view of Webb**

Claims 3-37 are rejected under 35 U.S.C. § 103 (a) as being unpatentable over Gamble (5,981,733) in view of Dorsel (2002/0132261) and further in view of Webb (6,599,693). As pointed out above, Dorsel cannot preclude patentability of the instant claims under 103(a). Similarly, the Webb reference cannot preclude the patentability of the instant claims under 103(a) as this patent was owned by Agilent

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<sup>1</sup> 35 U.S.C. 103(c): Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

or subject to an obligation of assignment to Agilent at the time the instant invention was made, as evidenced by an assignment executed by the inventors (Reel/Frame 011224/0998)(recorded on January 8, 2001). As such, this rejection may be withdrawn.

**Rejection of Claims 38-43 under 35 U.S.C. § 103 – Gamble in view of Dorsel and further in view of Pantano**

Claims 38-43 are rejected under 35 U.S.C. § 103 (a) as being unpatentable over Gamble (5,981,733) in view of Dorsel (2002/0132261) and further in view of Pantano (20030054176). As pointed out above, Dorsel cannot preclude patentability of the instant claims under 103(a). As such, this rejection may be withdrawn.

**CONCLUSION**

The applicants respectfully submit that all of the claims are in condition for allowance, which action is requested. If the Examiner finds that a telephone conference would expedite the prosecution of this application, please telephone Timothy Joyce at 650 485 4310. The Commissioner is hereby authorized to charge any fees under 37 C.F.R. §§ 1.16 and 1.17 which may be required by this paper, or to credit any overpayment, to Deposit Account No. 50-1078.

Respectfully submitted,

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